

### **REMARKS**

Claims 1-2, 4-22 and 24-43 are pending in the present application. Claims 1, 18, 21 and 35 are independent claims.

The claims have been amended to correct minor informalities and to clarify the invention according to U.S. patent practice. These modifications do not involve new matter.

### **Initialed PTO-1449 Needed**

Applicants filed an IDS on August 28, 2006. The Examiner is respectfully requested to return the initialed PTO-1449 form associated with it.

### **35 U.S.C. § 103 Rejection**

Claims 1, 2, 4, 8-22, 24-25 and 30-42 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman et al. (U.S. Patent No. 6,469,796) in view of Murphy et al. (U.S. Patent No. 6,076,110) and further in view of DeHority (U.S. Patent No. 5,129,6396). Claim 43 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman et al. in view of Murphy et al. and DeHority, as applied to claim 1 above, and further in view of Beck. Claims 5-7 and 26-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman et al. in view of Murphy et al. and DeHority, as applied to claim 1 above, and further in view of Applicants' disclosed related art. These rejections are respectfully traversed.

Regarding independent claims 1, 18, 21 and 35, the Examiner has basically maintained the same rejections over the same combination of the references, Leiman et al., Murphy et al. and DeHority. In the last filed response, Applicants have clearly provided multiple arguments why there would be no proper motivation to apply the teaching of DeHority (selecting the not-suitable device, for the job) to the Leiman-Murphy system (rejecting the not-suitable device, for the job). However, in the current Office Action, the Examiner has not responded to any of these arguments provided in Applicants' last filed response. The Examiner is respectfully requested to

provide the Examiner's response to each of Applicants' arguments, if the Examiner were to maintain the same rejection.

As discussed in the previous responses, Leiman excludes a non-suitable device from the set of selectable devices (e.g., see Leiman, col. 8, lines 12-18). In other words, Leiman searches for a device that is capable of printing the job exactly as required.

Murphy merely teaches to communicate a (virtual) device name with a server and does not add anything to Leiman with respect to Applicants' claimed features. That is, Murphy teaches a system wherein the selectability of a device is determined merely based on the availability of a device name. Thus, the Leiman-Murphy system is a system that searches for a device that is able to print the job exactly as required.

On the other hand, DeHority discloses a method and system that presents a print job, having certain print job settings, to one single printer (there is no selection of a printer among multiple printers in DeHority). If a certain feature of the print job is not available for that single printer, DeHority changes the setting such that the job is printed anyway, which may not be desirable.

That is, DeHority teaches away from the Leiman-Murphy system that requires the requested print job be carried out in the exact manner. One skilled in the art would recognize that the Leiman-Murphy system teaches to always make sure that a job is printed on a printer which is perfectly suitable for the job on hand. The Leiman-Murphy system even teaches to block unsuitable printers. Thus, for the Leiman-Murphy system, one skilled in the art would never search for or apply a document (such as DeHority) that teaches how to print a job on an unsuitable device nonetheless, thereby degrading the perfect execution of the job in the Leiman-Murphy system. In other words, there is absolutely no incentive or motivation to apply DeHority's teachings in the Leiman-Murphy system. It is basic patent law that if a reference teaches away from the suggested modification, then there is no proper motivation to make such modification and thus the rejection is improper.

Therefore, the combination of references as applied by the Examiner fails to teach or suggest, *inter alia*, “selecting a processing device out of all processing devices belonging to the set, wherein the processing device not suitable for the job is selectable to become the selected processing device” as recited independent claim 1. Other independent claims 18, 21 and 35 recite similar feature sin a varying scope.

Accordingly, independent claims 1, 18, 21 and 35 and their dependent claims are allowable over the applied references, and the rejections are improper and should be withdrawn.

### **Conclusion**

For the foregoing reasons and in view of the above clarifying amendments, Applicant(s) respectfully requests the Examiner to reconsider and withdraw all of the objections and rejections of record, and earnestly solicits an early issuance of a Notice of Allowance.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Esther H. Chong (Registration No. 40,953) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

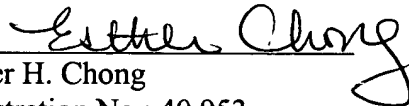
Application No. 09/878,962  
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If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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